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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,940	11/14/2003	Masashi Isono	024060-146	7417
21839	7590	03/08/2005		
BURNS DOANE SWECKER & MATHIS L L P POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER LESTER, EVELYN A	
			ART UNIT 2873	PAPER NUMBER

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/706,940	Applicant(s) ISONO, MASASHI	
	Examiner Evelyn A. Lester	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of original claims 2-5 and 9-16 is withdrawn in view of the newly discovered reference(s) to Shinohara (U.S. Patent 6,795,253 B2). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 3-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shinohara (U.S. Patent 6,795,253 B2).

Shinohara discloses the claimed invention (as noted for example in Figure 1 and Table 1 (at col. 5), as well as at column 7, lines 64-67) of a three-lens taking lens system having from an object side, a first lens element having a positive optical power, an aperture stop, a second lens element having a positive optical power and a third lens element having a negative optical power, wherein the first and second lens elements,

one is glass and the other is plastic, and the third lens element is made of plastic.

Several conditional statements are also met by Shinohara's lens system, as follows:

$$f/fG = 0.58, \text{ which is } >0.3 \text{ and } < 2.6;$$

$$TG/ fG = 0.138, \text{ which is } >0.05 \text{ and } < 1.35;$$

$$| f3 | / fP = 1.05, \text{ which is } < 2.6;$$

$$T3 / f = 0.26, \text{ which is } > 0.05 \text{ and } < 0.5; \text{ and}$$

$$VG = 58.7, \text{ which is } >58;$$

wherein the first lens is considered to be made of glass. Shinohara further teaches that that the first to third lens elements have at least an aspherical surface and the materials which form the lens elements are uniform materials, and as recited in claim 9, each of the three lens elements are meniscus lenses (i.e. Figure 1).

The Applicant should note that they have not perfected their foreign priority, which is why this prior art rejection is currently proper.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,744,570. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claimed invention is an obvious variation of the patent claimed invention.

Each of the claimed inventions have, from the object side, a first lens element with a positive optical power and made of glass, an aperture stop, a second lens element with positive optical power and made of plastic, and a third lens element with a negative optical power and made of plastic, wherein the a conditional statement is also met. The application claimed invention recites a conditional statement of:

$$0.3 < f/f_G < 2.6,$$

where "f" represents a focal length of the entire lens system and "f_G" represents a focal length of the glass lens element with positive power, which is the first lens element. The patent claimed invention's conditional statement of:

$$0.5 < f/f_1 < 1.6,$$

where "f" and "f₁" correspond directly to the variables of the application conditional statement, and the range value falls completely within the application conditional statement range values. Therefore, the patent claimed invention anticipates the application claimed invention.

Response to Arguments

4. Applicant's arguments with respect to claims 1 and 3-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sato (U.S. Patent 6,747,810 B2) is directed to a lens system having three lens units of positive, positive and negative optical power respectively from an object side.


Isono (US 2004/0021957 A1) is a related published US application of the Applicant.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M- F, from about 10 am to 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Evelyn A. Lester
Primary Examiner
Art Unit 2873